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McDermott, Will & Emery 600 13th Street, N.W. Washington, DC 20005-3096				
			EXAMINER	
			MUNSON, GENE M	
			ART UNIT	PAPER NUMBER
			2811	

DATE MAILED: 05/25/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/960,356
Filing Date: 09/24/2004
Appellant(s): Takashi Inbe

MAILED

MAY 25 2004

BERNARD P. CODD
For Appellant

GROUP 2800

EXAMINER'S ANSWER

This is in response to appellant's Brief on appeal filed 2 April 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the Brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the Brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the Brief is correct.

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(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the Brief is correct. The amendment filed 9 December 2003 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the Brief is deficient because the claimed "single channel height analyzer circuit" is not clearly described on page 3, lines 17 to 28 and page 6, lines 9 to 15, nor shown in a circuit diagram in any figure.

(6) *Issues*

The appellant's statement of issues in the Brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the Brief that the claims stand or fall together is agreed with.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the Brief is correct.

9) *Prior Art of Record*

The appealed rejection is not based on prior art of record.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

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Claims 3 and 5 are rejected under 35 U.S.C. 112, first paragraph. The specification, page 3, lines 21-28, and page 6, lines 2-17, does not clearly describe “a single channel height analyzer circuit for selecting only a pulse with a particular height to estimate an energy spectrum of the α rays with the aid of counting or by measuring peak height distribution using a current flowing through said PN junction”, as to enable any person skilled in the art to make the circuit.

Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph. In claim 3, in view of the specification, the scope of the “single channel height analyzer circuit for selecting only a pulse with a particular height to estimate an energy spectrum of the α rays with the aid of counting or by measuring peak height distribution using a current flowing through said PN junction” is unclear. Whether the “pulse” is current or voltage is unclear. How “selecting only a pulse with a particular height” is related to the “counting” or the “measuring peak height distribution” is unclear.

11) Response to Argument

Contrary to the Brief (page 4), during patent examination, it is *not* proper to read limitations appearing in the specification into a claim when these limitations are not recited in the claim. Claim 3 does not recite a “current pulse”. Furthermore, the specification, page 6, lines 9-11, does not state that a “pulse with particular height” on page 3, line 24, is a current pulse rather than a voltage pulse. Contrary to the Brief (pages 4-5), the specification, page 3, lines 21-28, and page 6, lines 2-17, does not describe how the “single channel height analyzer circuit” relates “selecting only a pulse with a particular height” to the “counting” or to “measuring peak height distribution”. Appellant does have a

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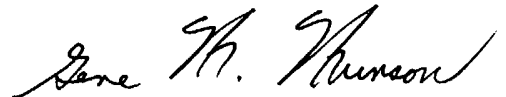
patentable invention and an allowed claim 4. Without the "single channel height analyzer circuit" limitation, as in rejected claim 3, the claim would be unpatentable under 35 U.S.C. 103, rather than 35 U.S.C. 112.

Contrary to the Brief (page 5-7), with regard to factors A through H, the specification does not clearly describe "a single channel height analyzer circuit for selecting only a pulse with a particular height to estimate an energy spectrum of the α rays with the aid of counting or by measuring peak height distribution using a current flowing through said PN junction." The breadth of claim 3 (factor A) with regard to the circuit is unclear and thereby so is the nature of the circuit invention (factor B). The Brief did not explain what the circuit is. Before the final rejection, Appellant provided no evidence related to factors C through H that the specification would enable any person skilled in the art to make the circuit, if we knew what the circuit is.

It is submitted that the claims are properly rejected as unpatentable.

Respectfully submitted,

Munson
5/14/2004



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